

REMARKS/ARGUMENTS

1. Claims 2-5 are rejected under 35 U.S.C. §112, second paragraph, for inclusion at lines 25+ of claim 2 of the phrase "while tending to avoid." The offending language has been removed from claim 2, and a minor conforming change made to claim 3. Claims 2-5 should now be allowable.

2. The Office Action appears to explicitly reject only claim 6. From the context, it appears that both claims 1 and 6 are rejected. The action is treated as rejecting both claims 1 and 6.

3. Claims 1 and 6 are rejected under 35 U.S.C. §103(a) as unpatentable over the admitted prior art in view of U.S. application 20020003776 to Gokhale.

It is noted that the priority date of the Gokhale reference antecedes applicant's priority date.

4. A 35 U.S.C. §103(a) rejection is normally based on a suggestion by Examiner that two or more references should be combined, and the resulting combination of references anticipates, or produces a one-to-one correspondence with, the claimed invention. The ability of Examiner to combine the references depends upon the showing of a proper relationship or nexus. The reason for this requirement is that all inventions are made up of old matter, and if unrestricted combination of prior art references were available, no invention could be patented. The courts have made it abundantly clear that references cannot be combined simply because they relate to the same subject matter. In the present case, it appears that

Examiner is attempting to combine the AAPA with Gokhale for that reason, and for no other reason.

Examiner in his rejection states

"AAPA teaches, with respect to paragraph 2 of claim 6, transmitting ABR ATM data and its associated resources management cells over a satellite (spacecraft). See page 1, lines 18-20, and page 3, lines 18-20 of Applicants written portion of the specification: 'Resource management cells are interspersed with the data cells of the ATM source signal.' AAPA also teaches, with respect to the last paragraph of this claim, that it is known in the art to mark the resource management cells with information regarding the presence of congestion before distributing them. See page 2, lines 28+. Note further that AAPA teaches the use of back Resource management cells which are used to control congestion through the use of a feedback control loop. See page 3, lines 18-22."

This is merely a recitation of those elements of the claim in question which Examiner believes to be found in a first reference.

Examiner goes on to state claim elements which are not found in the first reference

"While AAPA does discuss the problem associated with simplistic switching capabilities aboard satellites resulting in their incapability of setting bandwidth control bits (page 4, lines 15-20), AAPA does not teach a solution to this problem to comprise determining spacecraft payload congestion data relating to services associated with and including, among others, ABR, and then transmitting this

information to the source terminal, as required by lines 22-27 of this claim. AAPA does not, further teach a method of doing this without using routing switches onboard the satellite, and coupling the spacecraft congestion signals by way of a downlink to the source terminal. AAPA does not additionally teach deleting the Resource Management cells from the stream of AABR data."

Having described what is found in the relevant claim of the application and what is not found, Examiner goes on to state what is found in the second reference

"Gokhale et al teaches determining spacecraft payload congestion data relating to services associated with and including, among others, ABR, and then transmitting this information to the source terminal without using any routing switches onboard the satellite, and coupling the congestion signals by way of a downlink to the source terminal. See paragraphs 25 and 26."

Thus far, Examiner has recited those elements of the relevant claim which are found in the first reference, and those which are not found. In addition, he has recited those elements of the claim which are found in the second reference. This is the totality of Examiner's showing of a nexus and justification for the suggested combination of references. As mentioned, it is not sufficient to show that the references relate to the same subject matter, but instead there must be some suggestion within one reference or the other to suggest to the person of average skill in the art that the references be combined. In this instance,

there is not even an inkling of such a suggestion.

The lack of a proper nexus for Examiner's suggested combination of references, taken alone, is sufficient to prohibit the combination, which in turn results in the patentability of the claim at issue.

Yet further, Examiner goes on to state

"While neither Gokhale et al nor AAPA teach deleting the Resource Management cells, the examiner notes that it would have been obvious to one of ordinary skill in the art to have done so in view of the fact that since Gokhale et al uses an offboard system for communicating congestion information to the sending terminal (ie, via the intermediary satellite 4 in figure 4 of Gokhale et al), there would be no reason for communicating the Resource Management cells taught in AAPA."

which admits that even the combination of AAPA with Gokhale does not make a one-to-one correspondence between the claim and the combined references, which is fatal to a §103 rejection.

Examiner then draws his conclusion

"It would have been obvious . . . to have transmitted congestion information relating to the spacecraft and transmitted it to the source terminal of AAPA in light of the teachings of Gokhale et al. in order to provide a means for reducing congestion along the satellite link portion of the system."

There is no proper premise on which the conclusion is drawn, and it is defective.

The lack of a proper nexus for Examiner's suggested combination of references vitiates the effect of the suggested combination, so that the claims at issue are patentable over AAPA and Gokhale.

5. Reconsideration and allowance are requested.

6. No fee is believed to be required for this amendment. Please charge any other fees to deposit account 50-2061.

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by 

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